



UNITED STATES PATENT AND TRADEMARK OFFICE

A

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------------|------------------|
| 10/612,216   | 07/02/2003  | Mordechai Beyar      | 687-411                    | 5735             |
| 34205  | 7590        | 04/07/2005           |                            |                  |
| OPPENHEIMER WOLFF & DONNELLY LLP<br>45 SOUTH SEVENTH STREET, SUITE 3300<br>MINNEAPOLIS, MN 55402 |             |                      | EXAMINER<br>FARAH, AHMED M |                  |
|  |             |                      | ART UNIT<br>3739.          | PAPER NUMBER     |

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

|                              |                           |                  |  |
|------------------------------|---------------------------|------------------|--|
| <b>Office Action Summary</b> | Application No.           | Applicant(s)     |  |
|                              | 10/612,216                | BEYAR ET AL.     |  |
|                              | Examiner<br>Ahmed M Farah | Art Unit<br>3739 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 18 January 2005.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-10 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-10 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 3, 7-10 are again rejected under 35 U.S.C. 102(b) as being anticipated by Costello et al. U.S. Patent No. 5,322,507.

Costello et al. disclose a non-implantable device for the treatment of prostate, the device comprising:

a light source that provides a therapeutic light suitable for the required treatment, see the and col. 1, lines 16-25; and

a light source segment **68** that that houses a laser light transmitting fiber **70**, said light source segment is of sufficiently small size and configuration so that it can be inserted through the urethra of the patient as presently claimed, see Figs. 1B, 4, and col. 3, lines 53-56.

As to claims 7 and 8, the non-implantable device further comprises at least one light-attenuating lens **94**.

As to the new recitation “light source emitting light which is absorbed by blood” in claims 1 and 10, although Costello et al. teach the use of Nd:YAG laser for the treatment, they do not particularly describe the harmonic generation or wavelength of

said YAG laser. However, the Nd:YAG operatin the 1<sup>st</sup> harmonic (principle) generates light in the near IR of the electromagnetic spectrum. The IR light generated by said YAG laser is within the absorption spectra of water. Hence, the water in the blood inherently absorp the output radiation of said laser.

Note: The U.S. Patent '507 to Costello et al. is directed to the treatment of prostate. However, it is known that obstructive prostate gland enlargement or tumor causes a constant dripping or leakage of urine, i.e., Overflow incontinence. Hence, the device of Costello et al. is adapted to treat urological disorders as presently claimed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 2 and 4-6 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Costello et al. in view of Tulip U.S. Patent No. 5,059,200 and Ganz U.S. Patent No. 6,491,618.

However, Costello et al., described above, fail to teach the parameters of the light, such as the pulse duration or wavelength/color of the treatment light. They further fail to teach the use of tungsten halogen lamp as the source of irradiation.

Tulip teaches an alternative, non-implantable, laser lithotriptor for treating urological disorders, the lithotriptor comprising a pulsed light source having a pulse-width and wavelength as recited in the instant claims , see col. 7, lines 4-35. Ganz also teaches an alternative treatment device for treating urinary tract disorders by irradiation, the device comprising a tungsten halogen lamp as the source of radiation, see col. 2, lines 9-15 and col. 10, lines 39-54.

Therefore, it would have been obvious to one skilled in the art at the time of the applicant's invention to modify Costello et al. in view of Tulip and Ganz and use a pulsed or continuous wave generated by a laser or an incandescent lamp as an equivalent alternative source to provide the treatment light.

### ***Response to Arguments***

Applicant's arguments filed on January 18, 2005, have been fully considered but they are not persuasive. The applicant argues that Catello et al. (U.S. Pat. 5,322507) fail to disclose a light source that emits a light, which is absorbed by the blood in the blood vessel. As to Tulip (U.S. Pat. 5,059,200), although the Applicant admits the laser light of Tulip is absorbed by water, he nevertheless argues that the light of Tulip is not absorbed by blood as recited in the amended claims. Applicant further makes similar argument with respect to Ganz (U.S. Pat. 6,491,618).

In response to these arguments, Castello et al. teach the use of Nd:YAG laser, which emits near IR light. As admitted by the applicant, Tulip uses a laser source, which operates within the absorption band of water. Ganz clearly teaches the use of a

tungsten halogen lamp, which is analogous to the light source of the instant claims (see claim 2 of the instant application).

It is known that blood comprises water, red blood cells, hemoglobin, platelets, plasma, etc. Therefore, the examiner's position is that the water in the blood would inherently absorb the treatment lights disclosed by the prior art of record. As to Ganz, the tungsten light source is analogous to the one recited in the instant claims and, therefore, generates similar treatment energy.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahmed M Farah whose telephone number is (571) 272-

4765. The examiner can normally be reached on Mon-Thur. 9:30 AM-7:30 PM, and 9:30 AM - 6:30 PM on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M DVorak can be reached on (571) 272-4768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ahmed M Farah  
Primary Examiner  
Art Unit 3739

April 2, 2005.

